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| 09/592,741 | 06/13/2000 | Theresa M. Gosko | M-9083-US | 7322 |
| 33438 | 7590 | 09/01/2006 | EXAMINER | |
| HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720 | | | FISCHER, ANDREW J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,741

Applicant(s)

GOSKO, THERESA M.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9 and 30-39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,4-9 and 30-39 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Applicant's amendment filed February 21, 2006 has been entered. Accordingly, claims 1, 2, 4-9, and 30-39 remain pending.
2. This Office Action, the "Third Final Office Action" is given Paper No. 20060429.
3. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §112 2nd Paragraph

5. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1, 2, 4-9, and 30-39 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. In claims 1 and 30, it is unclear if Applicants are claiming a computer readable media in combination with a data structure, or as he seems to argue, a combination of a

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computer readable media in combination with a computer program. The resolution of this issue is key to this analysis and the application of the prior art.

Claim Rejections - 35 USC §102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 4-9, and 30-39 are rejected under 35 U.S.C. §102(e) as being anticipated by Johnson et. al. (U.S. 6,055,515)(“Johnson ‘515”). Johnson ‘515 discloses a computer readable medium in combination with a data structure.

9. As noted in the previous office action, because a medium is a physical tangible entity, it is the Examiner’s factual determination that Applicant has now claimed a product. Product claims are patentable for what they are, not what they do. See *e.g. In re Benner*, 174 F.2d 938, 942, 82 USPQ 49, 53 (CCPA 1949) (“no provision has been made in the patent statutes for granting a patent upon an old product based solely upon discovery of a new use for such product”). Because data structures *by definition* can not “do” anything (*i.e.* it is a *computer program* is the item or thing that actually *performs* actions), Applicants claims are simply a medium and a data structure. Because virtually all computer programs when executed are on a

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medium, and those medium contain data structures, the claims are anticipated by a large number of documents. Johnson '515 is simply selected as being exemplary of these documents.

Claim Rejections - 35 USC §103

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 4-9, and 30-39 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Riley, David D., Data Abstraction and Structure, An Introduction to Computer Science II ("Riley"). Riley discloses common data structures that are old and well known in the art. Riley does not directly disclose the computer readable medium. Riley's data structures are however understood to be used with a computer readable medium.

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Riley include a computer readable medium. Such a modification would have disclosed the normal and usual operation of Riley's data structures. Moreover, the missing elements in Riley are only found in the nonfunctional descriptive material and are not *functionally* involved in the product because data structures by definition have no functionality. If a data structure had functionality, it must be called a *computer program*.

In light of the above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Riley with any type of content or any type of data structure. The descriptive material will not distinguish the claimed invention over

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the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See also MPEP §2106 IV B.

12. Claims 1, 2, 4-9, and 30-39 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson '515 in view of Muller, Gralla, Riley, and Danish et. al.'s Building Database-Driven Web Catalogs ("Danish").¹ It is the Examiner's principle position that the claims are anticipated because Applicant claims only a medium and data structure. Moreover, a catalog record header portion is inherent in the catalog of Johnson '515.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Johnson '515 as taught by Danish to include Danish's use of headers. Such a modification would have disclosed that which is old and well known in the art.

13. In this rejection, Muller is cited simply to show an exemplary data structure such as web structures in an EDI environment (Page 83-86) which are old and well known in the art. Clearly one of ordinary skill in the art recognizes that EDI uses header portions (see *e.g.* Sokol, EDI, the Competitive Edge). Gralla is cited simply to show how the world wide web works. *E.g.*, see Part 5, How the World Wide Web Works. Riley is cited to show that all computer programs must have a data structure and to show data structures that are old and well known in the art.

14. The Examiner maintains his position that Applicant has elected to claim product claims. This issue will not be further addressed by the Examiner.

15. The Examiner maintains his position that Applicant is not his own lexicographer. This issue will not be further addressed by the Examiner.

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16. The Examiner maintains his position that the claims do not contain any product-by-process limitations. This issue will not be further addressed by the Examiner.

Response to Arguments

17. Applicant's arguments with respect to the claims have been considered but are not persuasive.

18. Regarding Applicants arguments, Applicant seems to stress the functionality of his claimed "data structure." However it is the Examiner's position that "data structures" by definition do not have any functionality because, by definition, they simply define *how* the data is to be stored. Data structures can not do anything and therefore have no functionality. However, if Applicant decided to change his claims and claim a *computer program* in combination with the computer readable media, the Examiner agrees that Applicant's arguments would have merit since both Applicant and the Examiner agree that *computer programs* have functionality. However the current claims are directed not to a computer program but to only a data structure. The Examiner respectfully asserts that an understanding of the difference between a 'computer program' and a 'data structure' is key to this analysis.

19. Applicant has elected to claim a product. The patentability of a product claim is not determined by what the product *does* for a patentee for a product claim receives a patent for *all* uses of that product.

20. Therefore Applicant's arguments with respect to "functionality" have been considered but are not persuasive.

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of

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Regarding Indefiniteness Under 35 USC §112 2nd Paragraph²

21. First, the Examiner notes that the primary purpose of the definiteness requirement is to provide notice. “The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction.” *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

22. Second, it is the Examiner’s position that during ex parte examination, if a claim in a utility patent application is indefinite on its face, the claim is indefinite. “If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted). Moreover, this definiteness determination is made as of the effective filing date. See e.g. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986) (analyzing definiteness as of the filing date).

23. Third, if a claim is indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to completely and accurately construe claim scope. See *Honeywell International Inc. v. ITC*, 68

inherency is present in the anticipation rejection.

² Because this application has now been at least twice rejected and is therefore eligible for appeal to the USPTO’s Board of Patent Appeals and Interferences (“Board”), because of recent decisions by the Board and the Board’s position on indefiniteness, and in order to help and enable Applicant to craft reasoned arguments should Applicant eventually decide to appeal an indefiniteness rejection to the Board, the Examiner has provided the following discussion on 35 USC §112 2nd Paragraph and indefiniteness.

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USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims in this application are construed and the art is applied *as much as practically possible*.

24. Forth, the Examiner recognizes that breath of a claim is not be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). However, “[i]f the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” MPEP §2173.02 citing *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). In other words, claim breath indicates the range or scope a claim limitation covers while the metes and bounds indicate where the claimed subject matter begins and ends. These are two principles are distinct and separate principles. A broad claim—like a narrow claim—may or may not have clear metes and bounds and thus may or may not be definite. Thus, if a person of ordinary skill in the art could not interpret the metes and bounds of a claim—even a broad claim—so as to understand how to avoid infringement, the claim is indefinite.³

³ *E.g.*, a claim that recites ‘a compound having a PH range that is greater than or equal to 0.01 PH and less than or equal to 13.99 PH’ is very broad and definite. Likewise, a claim that recites ‘a compound having a PH range that is greater than or equal to 6.85 PH and less than or equal to 6.87 PH’ is quite narrow yet still definite. However a claim that recites ‘a compound having a PH range that is greater than or equal to 0.01 PH and less than or equal to a PH value’ is broad and *indefinite* since the metes and bounds of the claim can not be reasonably determined. Likewise, a claim that recites ‘a compound having a PH range centered around 6.85 PH, plus or minus a given PH value’ may be considered narrow or broad and is therefore indefinite because

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25. Fifth, a claim in a utility patent application is either indefinite under 35 U.S.C. §112, 2nd paragraph or it is not. Contrary to recent decisions of the USPTO's Board of Patent Appeals and Interferences ("Board"), the law does not recognize a 'scale' or 'range' of indefiniteness such as 'slightly indefinite,' 'somewhat indefinite,' or 'not too indefinite.' There is no middle ground since at the end of the day, 'slightly indefinite,' 'somewhat indefinite,' or 'not too indefinite' are nevertheless still indefinite. The Examiner frequently receives arguments from applicants and decisions from the Board where the parties respectively argue that 'the examiner knows what is meant by the term' or 'the language is clear from the specification.' However these arguments can not overcome claim language that is indefinite on its face. In other words, "semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]" *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).⁴

Again, so as to be especially clear, a claim is either indefinite—or it is not indefinite. When the claim is indefinite, the claim by definition, can not be construed. And if the indefiniteness is

again, the metes and bounds of the claim can not be reasonably determined by the claim language itself. In the last two examples, a person of ordinary skill in no matter what the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

⁴ As a practical matter, a patent applicant almost always has an opportunity to correct indefiniteness by filing either an amendment to a non final office action, or alternatively if in response to a final office action, a request for continued examination under 37 C.F.R. §1.114 along with an amendment.

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rendered during ex parte examination, neither the specification nor the prosecution history can be used to rectify the indefiniteness.⁵

26. Sixth, the Examiner recognizes that “compliance with Section 112 Para. 2 is a question of law.” *In re Dossel*, 115 F.3d 942, 944, 42 USPQ2d 1881, 1883 (Fed. Cir. 1997). Additionally, when questions of indefiniteness arise, we use general principles of claim construction. “In the face of an allegation of indefiniteness, general principles of claim construction apply.” *Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 75 USPQ2d 1801, 1805 (Fed Cir. 2005) citing *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1340-41, 65 USPQ2d 1321, 1326 (Fed. Cir. 2003) (noting that a determination of definiteness “requires a construction of the claims according to the familiar canons of claim construction”). However, a patent claim that is indefinite on its face can not be rendered ‘definite’ by a reviewing body simply because the result would otherwise be inequitable or unfair to applicant, because the result would otherwise be too harsh or severe since it might result in the patent application becoming abandoned, or because rendering the claim indefinite is against some noble policy. “Claim construction, however, is not a policy-driven inquiry. As stated earlier, it is a contextual interpretation of language. The scope of patent claims can neither be broadened nor narrowed based on abstract policy considerations regarding the effect of a particular claim meaning.” *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 70 USPQ2d 1737, 1742-43 (Fed. Cir. 2004) (quoting

⁵ Cf. *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001) vs. *In re Jolly*, 172 F.2d 566, 80 USPQ 504 (CCPA 1949). In *Exxon Research*, the Federal Circuit reviewed “similar claim language” as was interpreted in *Jolly* (where the language in question was held to be indefinite) and held that for purposes of indefiniteness, claims are interpreted differently during ex parte examination than the same claim phases during inter partes litigation.

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Quantum Corp. v. Rodime, PLC, 65 F.3d 1577, 1584, 36 USPQ2d 1162, 1168 (Fed. Cir. 1995)

("[I]t is well settled that no matter how great the temptations of fairness or policy making, courts do not redraft claims"), *vacated on other grounds by* 403 F.3d 1328, 74 USPQ2d 1396 (Fed. Cir. 2005)(en banc).

27. Seventh, should Applicants appeal this application and should the Board have any questions regarding indefiniteness under 35 U.S.C. §112, 2nd paragraph and its application during ex parte examination when compared with inter partes litigation, the Examiner respectfully requests the Board to remand this application to the Examiner in order for the Examiner to provide additional analysis and guidance.

28. The Examiner concludes this section by reiterating that during ex parte examination, when a patent claim is rejected for indefiniteness because the claim is indefinite on its face, the claim can not be construed. In such a case, the application of prior art by an examiner or the Board is immaterial. Yet in order to avoid piecemeal examination, MPEP §2173.06 states that even if the examiner takes a position that a claim is indefinite, it is USPTO policy to nevertheless make an attempt at application of the prior art. However, neither this policy decision as set forth in MPEP §2173.06 nor even *any* policy decision by the USPTO can change the substantive standard for indefiniteness and thus the standard for a 35 U.S.C. §112 2nd paragraph rejection.⁶ So no matter how slight the indefiniteness may be, no matter how equitable Applicant's arguments may seem, and no matter how great the temptations of fairness or policy making may

⁶ See *Merck &Co. v. Kessler*, 80 F.3d 1543, 1559, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996)("As we [the Federal Circuit] have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. Section 6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does not grant the Commissioner the authority to issue substantive rules.").

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appear to the Board, during ex parte examination, if a claim is indefinite on its face, the claim is just that—indefinite.

Conclusion

29. Applicants' amendment and arguments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, this action is made final. See MPEP §706.07(a). Applicants are respectfully reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a). A shortened statutory period for reply to this final action is set to expire three months from the mailing date of this action. In the event a first reply is filed within two months of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than six months from the date of this final action.

30. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

31. All citations in this office action are for due process purposes only and are not necessarily following a particular standard, requirement, court rule, or convention.

32. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence

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provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8th Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

34. Because this application is now final, Applicant is respectfully reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102

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and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

35. Applicant is respectfully reminded that patents are written by and for skilled artisans. See *e.g. Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).⁷ The Examiner therefore starts with the presumption that Applicant is a skilled artisan who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant’s response must also state *why*

⁷ See also *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001)(“patents are written for persons experienced in the field of the invention”).

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he either does not understand or *why* he has difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicant's response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicant is given actual notice that this paragraph becomes effective when Applicant receives notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicant submits an Information Disclosure Statement or when Applicant receives an examiner's Notice of References Cited (Form PTO-892)).

36. Additionally, Applicant is respectfully reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, the USPTO uses the preponderance of the evidence standard.⁸ In light of this standard, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All the evidence on the question of obviousness must be considered."); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of

⁸ See MPEP §706 I. "The standard to be applied in *all* cases is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable. [Emphasis added.]"

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evidence with due consideration to persuasiveness of argument. [Emphasis added.]”); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002)(“Patentability vel non is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does not consider *all* relevant evidence of record may not be supported by the required substantial evidence⁹ since the particular evidence *not* considered may be probative of a factual issue presented. Forth, prior art patents are not technical treatises and therefore these patents intentionally omit features that are known in the field of the invention. See *S3 Inc. v. nVIDIA Corp.*, 259 F.3d at 1371, 59 USPQ2d at 1749-50 (“The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader.”); and *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)(“The specification would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel.”). Finally and perhaps most importantly, it is well established that “[a] reference anticipates a claim if it discloses the

⁹ See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000) where the Federal Circuit concluded that USPTO’s factual findings must be supported by substantial evidence.

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claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.¹⁰ Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence of record *not* considered by the USPTO may be probative of at least one factual issue presented, and because anticipation is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, Applicant is hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

37. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position

¹⁰ See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*.

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regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 6) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹¹ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
April 29, 2006

¹¹ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.